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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,685	08/23/2001	Chiaki Hashimoto	3064YA/50332	8396

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CROWELL & MORING, L.L.P.  
P.O. Box 14300  
Washington, DC 20044-4300

EXAMINER

SHIBRU, HELEN

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/934,685

Applicant(s)

HASHIMOTO, CHIAKI

Examiner

HELEN SHIBRU

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                                |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/20/2005</u> . | 6) <input type="checkbox"/> Other: _____                                                |

***Information Disclosure Statement***

1. The information disclosure statement filed in 8/23/2001 and 7/20/2005 fails to comply with 37 CFR 1.97(c) because they lack a statement as specified in 37 CFR 1.97(e). The examiner only considered the abstract of these IDS, and the translation should be provided.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites 'a story portion reproducing means for unconditionally reproducing a story portion upon exchanging said disks when said all-repeat-mode is set'. The claim is unclear as to how the story portion is unconditionally reproduce when all-repeat-mode is set. The examiner carefully looked at the word 'set' in this claim with respect to figure 12 and the disclosure, and considered it for both setting the all-repeat-mode to "ON" or "OFF" to determine if the story portion is unconditional or not. First, if the 'all-repeat-mode' is set to "ON" the process will continue from step 5 to step 21 of fig. 12. These steps are conditional. For example, identifying the disk is conditional. Second, if the 'all-repeat-mode' is set to "ON" the reproduce process will be normal and the story portion will be unconditional. However, claim 2 recites 'obtaining a start address of said story portion' which indicates the story portion is unconditional.

Furthermore paragraph 0009 of the disclosure states, "...after obtaining a start address of the story portion in order to unconditionally reproduce..." Obtaining the start address is conditional.

*WordNet*® dictionary defines the word ***unconditional*** as 1: not conditional; "unconditional surrender" 2: not modified or restricted by reservations; "a categorical denial"; "a flat refusal" 3: not contingent; not determined or influenced by someone or something else.

Therefore the examiner respectfully suggests to replace or remove the word "unconditional" and specifically recite setting the repeat mode to either 'ON' or 'OFF'. Setting the repeat mode can interpret as 'setting it to 'ON' or 'OFF''

Claim 6 is rejected for the same reason as discussed in claim 1 above.

Claims 3-5 and 7-10 are rejected for being dependent upon the rejected claims 1 and 6.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto (5,748,585).

Regarding claim 1, Tsukamoto discloses a setting means for setting an all-repeat-mode (see col. 44 lines 13-53); an exchanging means for exchanging said disks (see fig. 24 disc changer mechanism (318), disc motor (318) and disc loading section (319), and col. 36 lines 10-22); and a story portion reproducing means for unconditionally reproducing a story portion upon

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exchanging said disks when said all-repeat-mode is set (see col. 22 lines 50-60, col. 23 lines 29-44 and line 66-col. 24 line 10, col. 36 lines 10-22, col. 43 line 66-col. 44 line 8 and line 13-29 and col. 45 lines 7-20. The repeat mode is set already and the portions are playing back without interruption in the event the disc is changing). Although Tsukamoto does not specifically disclose a DVD-auto changer, Tsukamoto discloses a disc changer for exchanging the loaded disc (see col. 34 lines 10-22). Official Notice is taken that the use of DVD (digital versatile disc) type media is well known in the art to store more audio, video, or other data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify Hickey by utilizing the DVD to take advantage of the higher storage data capacity.

Regarding claim 2, Tsukamoto discloses story portion reproducing means includes an obtaining means for obtaining a start address of said story portion, and a reproduction executing means for reproducing from said start address (see col. 23 lines 66-col. 24 line 10, col. 29 lines 23-33, col. 30 lines 1-18 and lines 40-65).

Regarding claim 3, Tsukamoto discloses start address of said story portion is a start address of a specified chapter included in a specified title (see col. 34 lines 47-54).

Regarding claim 4, Tsukamoto discloses specified chapter of said specified title is a first chapter included in a first title (see col. 32 line 50-col. 33 line 12).

Claims 6-9 are rejected for the same reason as discussed in claims 1-4 above.

***Allowable Subject Matter***

6. Claims 5 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 5 and 10, the Prior Art fails to teach or suggest the method and apparatus of claims 1 and 6 including a detecting means for detecting a data group having a longest data length, and said obtaining means obtains a start address of said data group having the longest data length.

#### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES J. GROODY can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Helen Shibru  
December 2, 2005

  
James J. Groody  
Supervisory Patent Examiner  
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